



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/943,776	10/03/1997	MARIAPIA A. DEGLI-ESPOSTI	2849-A	9687

22932 7590 07/23/2002

IMMUNEX CORPORATION
LAW DEPARTMENT
51 UNIVERSITY STREET
SEATTLE, WA 98101

EXAMINER

LAZAR WESLEY, ELIANE M

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 07/23/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/943,776

Applicant(s)
Degli-Esposti

Examiner
Eliane Lazar-Wesley

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7, 10, 11, 13, 14, 16, and 22-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 10, 11, 13, 14, 16, and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1646

DETAILED ACTION

1. Prosecution is reopened.
2. The indicated allowability of claims 1-3, 6, 7, 10, 11, 13, 14, 16 and 22-26 is withdrawn in view of the reference to Yu et al, US Patent 6,153,402, issued November 28, 2000 with priority to provisional applications 60/013,285 (filed March 12, 1996); 60/028,711 (filed October 17, 1996) and 60/037,341 (filed February 6, 1997). Provisional application 60/013,285 (filed March 12, 1996) discloses a polypeptide of 428 amino acids, which is the polypeptide of SEQ ID No:2 of US Patent 6,153,402. Provisional application 60/028,711 (filed October 17, 1996) discloses a polypeptide of 417 amino acids, which is the polypeptide of SEQ ID No: 4 of US Patent 6,153,402.

Rejections based on the newly cited references follow.

It has been established that the priority data for the instant polypeptide of 417 amino acids having SEQ NO:2 is the filing date of the parent US Application 08/720,864, filed October 4, 1996, which has been converted to provisional application 60/044,456. This date is prior to

Priority for the instant polypeptide of 411 amino acids having SEQ ID NO:6 is the filing date of the instant application, which is October 03, 1997.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

Art Unit: 1646

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3, 6, 7, 10, 11, 13, 14, 16 and 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu et al, US Patent 6,153,402.

Yu teaches a death domain receptor of 428 amino acids of SEQ ID No: 2, and DNA encoding it. Amino acids 1-35 constitute the signal peptide, amino acids 36-212 constitute the extracellular domain, amino-acids 213-235 constitute the transmembrane domain, amino acids 236-428 constitute the intracellular domain, and amino acids 353-419 the death domain (col.4, l.27). Yu's receptor is 97.6% identical at position 8-428 to the instant SEQ ID NO:2 at position 3-417, and 100% identical at position 25-428 to the instant SEQ ID NO:2 at position 14-417 (see sequence comparison, attached).

Yu therefore anticipates the claims, as they are addressed to fragments of the polypeptide of SEQ ID No:2 capable of inducing apoptosis, or to DNA that hybridizes the complement of the DNA encoding the polypeptide, or fragments thereof.

However, the instant application, having priority to provisional application 60/044,456, filed October 4, 1996, constitutes the prior art for the 417 amino acid sequence of SEQ ID No:2, because Yu's priority data for the 417 amino acid sequence (referred as SEQ ID No:4 in the issued patent)

Art Unit: 1646

has been determined to be the filing date of provisional application 60/028,711, which is October 17, 1996.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliane Lazar-Wesley, PhD, whose telephone number is (703) 305 4059. The examiner can normally be reached on Monday-Friday from 9:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308 4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

ELW

July 18, 2002

EW



LORRAINE SPECTOR
PRIMARY EXAMINER